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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/653,294	05/24/96	CLAYBERGER	286002020023

HM12/1004

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EXAMINER

DIBRINO, M

ART UNIT	PAPER NUMBER
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1644

DATE MAILED: 10/04/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/653,294

Applicant(s)

Clayberger et al

Examiner
Mariann DiBrino

Group Art Unit
1644



☒ Responsive to communication(s) filed on Dec 20, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-8, 12, 13, and 15-26 is/are pending in the application

Of the above, claim(s) 22-26 is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-8, 12, 13, and 15-21 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

1. The request filed on 9/18/00 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/653,294 is acceptable and a CPA has been established. An action on the CPA follows.

2. The amendment filed 12/20/99 and the response filed 2/14/00 are acknowledged and have been entered.

Claims 1-8, 12, 13 and 15-26 are pending.

Claims 1-8, 12, 13 and 15-21 are presently being examined.

3. This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the reason(s) set forth on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures.

Applicants are required to amend the specification to list the appropriate SEQ ID NOS for sequences disclosed in the specification. The sequence listing filed 12/20/99 does not contain all the sequences disclosed in the specification.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-8, 12-13, 15-17, 20 and 21 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claims 1-8, 12, 13, 15-17, 20 and 21 are indefinite in the recitation of "portion" on lines 7 and 9 of claim 1 because it is not clear what is meant.

b. Claims 1-8, 12, 13, 15-17, 20 and 21 are indefinite in the recitation of "independently selected from the group consisting of: wherein α is..." because it is not clear what is meant.

c. Claims 1-8, 12, 13, 15-17, 20 and 21 are indefinite because the α and β peptides can not be the same as recited on line 11 because on lines 16-17 the α and β peptides do not share the same sequences.

In view of the amendment filed 12/20/99 only the following rejection remains.

6. Claims 1-8, 12, 13, 15-17, 20 and 21 stand rejected under 103(a) as being unpatentable over Olsson, U.S. Patent No. 5,073,540 or WO 88/05784 for the reasons of record in Paper No. 29, mailed 8/16/99.

Applicant's arguments filed 1/20/00 have been fully considered but they are not persuasive.

In response to Applicant's argument of unexpected results of the peptide on page 7, Applicant is reminded that the scope of the claims must convey the unexpected showing.


7. No claim is allowed.

8. This action is made NON-final as a courtesy to Applicant.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne DiBrino whose telephone number is (703) 308-0061. The examiner can normally be reached Monday through Friday from 8:30 am to 6:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 305-3014.

Marianne DiBrino, Ph.D.
Patent Examiner
Group 1640
Technology Center 1600
September 29, 2000


CHRISTINA Y. CHAN
SUPERVISORY PATENT EXAMINER
GROUP ~~1800~~ 1640